

## REMARKS

### **I. Response to Restriction Requirement**

During prosecution of the instant application, the Examiner issued a five-way restriction requirement. In response, Applicants cancelled original claims 1-33 and introduced new claims 34-37 by way of preliminary amendment. Applicants explained that the introduction of new claims 34-37 reflected the Applicant's election of group IV (corresponding to canceled claims 24-27).

The Applicants would like to thank the Examiner for the phone conversation on October 16, 2003, during which the instant amendment and response were discussed. Briefly, the Examiner urged that Applicants, notwithstanding the introduction of new claims 34-37, failed fully respond to the restriction requirement by failing to elect one of the inventions (A)-(D).

In response to the restriction requirement, Applicants provisionally elect examination of Group (A) (corresponding to SEQ ID NO:1 or a sequence encoding SEQ ID NO:2). This election is made *with traverse*.

### **II. Traversal of Restriction Requirement**

Applicants respectfully request that the restriction requirement be reconsidered. As discussed with the Examiner during the October 16, 2003, teleconference, Claims 34-37 adopt the language of allowed claims in related U.S. Patent No. 6,350,603 (hereinafter "the '603 patent"). The '603 patent was examined by the same Examiner, and the allowed claims in the '603 patent include claims encompassing each of the asserted separate inventions (A)-(D) (See, for example, claim 1 of the '603 patent). Accordingly, Applicants submit that restriction of the instant application to one of (A)-(D) is improper.

In addition to the fact that claims similar to instant claims 34-37 were allowed in the related '603 patent, Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all of the members of the Markush group.

MPEP §803.02 states:

If the members of a Markush group are sufficiently few in number or so closely related that search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case...will not require restriction. (emphasis added)

At the outset, Applicants point out that only 4 amino acid sequences and their corresponding polynucleotide sequences comprise the asserted separate inventions (A)-(D). Accordingly, the members of the Markush group are sufficiently few in number that the Examiner would not be seriously burdened to examine all of the members.

Although the polynucleotides recited in claim 34 are chemically distinct, the polynucleotides share a common utility and share a substantial structural feature essential to that utility, and thus satisfy the unity of invention requirement. Each polynucleotide encodes a phosphodiesterase polypeptide which can be used to identify a specific binding partner compound of said phosphodiesterase polypeptide. Furthermore, even if the polynucleotides are distinct or independent inventions, the Examiner has not shown that a serious burden would be required to search and examine all of the polynucleotides of the Markush group. (See M.P.E.P. §803.02 above). For example, each of the sequences set out in SEQ ID NOs: 1, 18, 20, and 22 have a high sequence similarity (See, for example, Example 1). Further, not only do these sequences share high sequence similarity, the sequences also would hybridize under the conditions set out in claim 34. Indeed, the sequences were initially characterized as potential PDE sequences as a result of the database search strategy outlined in Example 1 of the specification.

Applicants respectfully submit that the Examiner has not shown that the criteria for a proper restriction requirement have been satisfied. The Office Action (Communication mailed March 3, 2003) fails to provide any showing that it would be a serious burden on the Examiner to search and examine each member of the Markush group. Accordingly, Applicants respectfully request that the Examiner reconsiders the restriction requirement.

## **II. The Amendments**

Applicants have amended claim 34 solely to comply with the Examiner's restriction requirement. However, if it is determined that SEQ ID NOS: 2, 19, 21, and 23, and their corresponding polynucleotide sequences, comprise a single invention, Applicant's reserve the right to re-introduce such subject matter. Alternatively, even if such subject matter is found to comprise separate and distinct inventions, Applicants reserve the right to re-introduce such subject matter in a dependent claim. Such a dependent claim is supported in the specification as originally filed since the polynucleotide sequences share a high degree of similarity and would hybridize under the conditions set out in claim 34.

Respectfully submitted,

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